

## REMARKS

Claims 1-9 are pending in this application.

### Double Patenting Rejections

- A. Response to provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-26 of copending Application No. 10/577,270 (US 2007/0078224) of Dominic et al.

In response to the provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-26 of copending Application No. 10/577,270 (US 2007/0078224) of Dominic et al. ("Dominic"), Applicants respectfully traverse the rejection.

First, Applicants note that claims 1-13 of Dominic were cancelled, as shown in US Publication Number 2007/0078224, so that claims 14-26 are pending. Applicants will refer to these claims.

Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103, are also employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- a) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- b) Determine the differences between the scope and content of the patent claim as determined in a) and the claim in the application at issue;
- c) Determine the level of ordinary skill in the pertinent art; and
- d) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Additionally, any obviousness-type double patenting rejection should make clear:

- a) The differences between the subject matter defined by the conflicting claims – a claim in the cited document compared to a claim in the application; and
- b) The reasons *why* a person of ordinary skill in the art would conclude that the subject matter defined in the claim at issue is anticipated by, or would have been an obvious variation of, the subject matter defined in a claim in the cited document. (MPEP 804)

Moreover, when considering whether the subject matter defined in a claim of an application would have been an obvious variation of the subject matter defined in the claim of a patent, or another patent application, the disclosure of the patent or other patent application may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992), (Emphasis added).

With respect to the current rejection, the pending claims relate to a polyolefin composition in claim 1 and its dependent claims, a process for making polyolefin compositions in claim 6 and its dependent claims, and injection molded articles made from the polyolefin composition in claim 9.

Claim 1 recites:

Polyolefin compositions comprising, in percent by weight based on a total weight of the polyolefin compositions:

- 1) 55-90% of a crystalline propylene homopolymer or copolymer containing up to 15% of at least one of ethylene and C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) and having a value of MFR (230 °C, 2.16 kg) of at least 25 g/10 min; and
- 2) 10-45% of a copolymer of ethylene with at least one C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) containing from 10 to 40% of said C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s);

said compositions having MFR values of at least 20 g/10 min, a total content of ethylene of at least 20%, a total content of C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) of at least 4.5%, a ratio of the total content of ethylene to the total content of C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) of at least 2.3, a total fraction soluble in xylene at room temperature of less than 18 wt% and an intrinsic viscosity value of the fraction soluble in xylene at room temperature of at most 1.7 dl/g.

In an argument supporting the rejection, the Examiner stated in the Office Action that

[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the compositional limitations for the polymers and for the constituents included therein overlap. (page 3, lines 3-6)

First, even if the Examiner's conclusion as to claim overlap was correct, the Examiner has not fulfilled his obligation to present the reasons *why* a person of ordinary skill in the art would conclude that the subject matter defined in the claim at issue is anticipated by, or would have been an obvious variation of, the subject matter defined in Dominic. This is the Examiner's burden, as described above, and Applicants respectfully submit that for this reason alone the rejection should be withdrawn.

However, the Examiner's conclusion is not correct. In arguing that Dominic's claims and those currently recited overlap, the Examiner was presumably referring to the possibility of overlap in component properties that may exist between the 3-component system of Dominic and the 2-component system of the current claims, but there is clearly no overlap in the limitations directed to the composition as a whole. In fact, none of Dominic's claims recite a limitation directed to the composition as a whole as in the currently recited claims. Moreover, Dominic has no claims directed to a process for making a composition or an injection-molded article made from the composition. Clearly, a person of ordinary skill in the art would not conclude that the subject matter recited in the current claims is anticipated by, or would have been an obvious variation of, the subject matter defined in a Dominic's claims.

Reconsideration and withdrawal of the rejection respectfully is requested.

B. Response to rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,441,094 of Cecchin et al. ("Cecchin").

In response to the rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,441,094 of Cecchin et al. ("Cecchin"), Applicants respectfully traverse the election.

The requirements for an obviousness-type double patenting rejection have been summarized in paragraph A above.

In support of the rejection, the Examiner has argued that

[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the compositional limitations for the polymers and for the constituents included therein overlap. The identical composition may be embraced by the patented claims. (page 3, lines 11-14) (Emphasis added)

First, even assuming that the Examiner's conclusion that the composition "may be embraced by the patented claims" is correct, this is not the required standard for formulating a double patenting rejection. However, as this is the Examiner's burden, as described above, Applicants respectfully submit that for this reason alone the rejection should be withdrawn.

However, the Examiner's conclusion is not correct. First, Cecchin's claims recite a 3-component system (A<sup>I</sup>, A<sup>II</sup>, and B), in contrast to the 2-component system of the current claims. Moreover, at the least Cecchin's claims do not recite a total content of ethylene of at least 20%, a total content of C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) of at least 4.5%, or a ratio of the total content of ethylene to the total content of C<sub>4</sub>-C<sub>10</sub>  $\alpha$ -olefin(s) of at least 2.3. Clearly, a person of ordinary skill in the art would not conclude that the subject matter recited in the current claims is anticipated by, or would have been an obvious variation of, the subject matter defined in a Cecchin's claims.

Reconsideration and withdrawal of the rejection respectfully is requested.

#### Rejections Under 35 U.S.C. § 102

C. Response to rejection of claims 1-9 under 35 U.S.C. §102(e) as being anticipated by Cecchin.

In response to the rejection of claims 1-9 under 35 U.S.C. §102(e) as being anticipated by Cecchin, Applicants respectively traverse the rejection.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim.

*Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Examiner has not commented at all on the elements of any of the pending claims, or made any showing or comment of where they are to be found in the cited reference. Therefore, Applicants respectively submit that the required showing under §102 has not been made. Reconsideration and withdrawal of the rejection respectfully is requested.

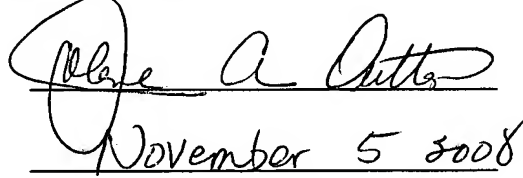
The Commissioner is hereby authorized to charge U.S. PTO Deposit Account 08-2336 in the amount of any fee required for consideration of this Amendment.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 5, 2008.



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